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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,892	08/29/2001	Eric D. Anderson	500247.03	2384

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Mark W. Roberts, Esq.
DORSEY & WHITNEY LLP
Suite 3400
1420 Fifth Avenue
Seattle, WA 98101

EXAMINER

ENGLAND, DAVID E

ART UNIT

PAPER NUMBER

2156

DATE MAILED: 09/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

7M

Office Action Summary

Application No.

09/943,892

Applicant(s)

ANDERSON, ERIC D.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 30 – 36 are presented for examination.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 30, 31, 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Brandt et al. U.S. Patent No. 6377993 (hereinafter Brandt).

3. Referencing claim 30, Brandt teaches a computer-implemented method for one of a plurality of designated recipients of an electronic communication to receive the electronic communication from a server that stores a single copy of the electronic communication, the method comprising:

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4. receiving an electronic communication notification from the server that references the single copy of the electronic communication, the electronic communication notification distinct from the electronic communication, (e.g. col. 21, line 57 – col. 22, line 35);

5. requesting from the server the referenced electronic communication, (e.g. col. 4, lines 28 – 58);

6. and

7. to receiving from the server a copy of the requested electronic communication, (e.g. col. 16, line 56 – col. 17, line 36).

8. Referencing claim 31, Brandt teaches when access to the electronic communication is no longer desired, indicating to the server to delete the electronic communication, so that the server deletes the single stored copy of the electronic communication after receiving indications from all recipients to delete the electronic communication, (e.g. col. 27, lines 1 – 15).

9. Referencing claim 36, Brandt teaches wherein contents of the received electronic communication notification are based on preferences for the one of the plurality of designated recipients, the preferences previously supplied to the server, (e.g. col. 21, line 57 – col. 22, line 17).

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt (6377993) in view of Bapat et al. (6236996) (hereinafter Bapat).

12. As per claim 32, Brandt teaches after the indicating to the server to delete the electronic communication, deleting the stored electronic communication notification even if all recipients have not indicated to delete the electronic communication, (e.g. col. 27, lines 1 – 15). Brandt does not specifically teach after the receiving of the electronic communication notification, storing the electronic communication notification locally. Bapat teaches after the receiving of the electronic communication notification, storing the electronic communication notification locally, (e.g. col. 14, lines 43 – 65). It would have been obvious to one skilled in the art at the time the invention was made to combine Bapat with Brandt because if a user has a personal records of electronic communication notifications it could prevent loss of information if the server were to break down and/or crash, (i.e. redundancy).

13. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt (6377993) in view of Herz (6029195).

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14. As per claim 33, Brandt does not specifically teach storing the electronic communication locally such that the local stored electronic communication is preserved even when the server deletes the single stored copy. Herz teaches storing the electronic communication locally such that the local stored electronic communication is preserved even when the server deletes the single stored copy, (e.g. col. 60). It would have been obvious to one skilled in the art at the time the invention was made to combine Herz with Brandt because if a user has a personal records of electronic communication notifications the user would not have to rely on the server incase the electronic communication notifications was deleted by accident or if the server were to break down and/or crash, (i.e. redundancy)

15. As per claim 34, Brandt does not specifically teach the electronic communication received from the server is encrypted using a public encryption key for the one of the plurality of designated recipients, and including retrieving a private encryption key for the one of the plurality of designated recipients to decrypt the electronic communication. Herz teaches the electronic communication received from the server is encrypted using a public encryption key for the one of the plurality of designated recipients, and including retrieving a private encryption key for the one of the plurality of designated recipients to decrypt the electronic communication, (e.g. col. 39, line 57 – col. 40, line 33). It would have been obvious to one skilled in the art at the time the invention was made to combine Herz with Brandt because it would provide for secure transmission for private information.

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16. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt (6377993) in view of Wollrath et al. (6263350) (hereinafter Wollrath).

17. As per claim 35, Brandt does not specifically teach wherein the method is performed by a receiving computer lacking sufficient permanent storage to store the electronic communication. Wollrath teaches wherein the method is performed by a receiving computer lacking sufficient permanent storage to store the electronic communication, (e.g. col. 13, line 50 – col. 14, line 35). It would have been obvious to one skilled in the art at the time the invention was made to combine Wollrath with Brandt because if a user were to have insufficient permanent storage space, one would want another means for storage, (i.e. server), therefore freeing up storage space on the receiving computer for other data.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. a. Namba U.S. Patent No. 6170006 discloses Video on demand service system for performing automatic expanding processing of data and title information.

20. b. Ali et al. U.S. Patent No. 5940594 discloses Distributed storage management system having a cache server and method therefore.

21. c. Lewis et al. U.S. Patent No. 6233565 discloses Methods and apparatus for internet based financial transactions with evidence of payment.

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22. d. Krebs et al. U.S. Patent No. 5448759 discloses Method for efficient bandwidth utilization when transceiving varying bandwidth messages.
23. e. Gill et al. U.S. Patent No. 6052514 discloses Distributed publication system with simultaneous separate access to publication data and publication status information.
24. f. Hussey U.S. Patent No. 6230156 discloses Electronic mail interface for a network server.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alvin Oberley can be reached on 703-305-9761. The fax phone numbers for the organization where this application or proceeding is assigned are none for regular communications and none for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is none.

David E. England
Examiner
Art Unit 2156

De *DE*
September 19, 2002



JOHN A. FOLLANSBEE
PRIMARY EXAMINER